

Remarks

Reconsideration of this Application is respectfully requested.

Upon entry of the foregoing amendment, claims 1-11, 16-26, and 46-56 are pending in the application, with 1, 16, 46 and 53 being the independent claims. Claims 12-15 and 27-45 are sought to be cancelled without prejudice to or disclaimer of the subject matter therein. New claims 46-56 are sought to be added. Claims 1, 4, and 16 are amended. These changes are believed to introduce no new matter, and their entry is respectfully requested.

The foregoing amendment is hereby submitted for the Examiner's consideration to better place the present application in condition for allowance, in accordance with 37 C.F.R. § 1.116(a). Based on the above amendment and the following remarks, Applicants respectfully request that the Examiner reconsider all outstanding objections and rejections and that they be withdrawn.

Priority

The Examiner has noted that the present application 09/864,293 is a Continuation-In-Part (CIP) of Applications 09/559,964 and 09/393,390. The Examiner has alleged that this Application, 09/864,293, does not benefit from an earlier filing date due to inadequate support. (See Office Action, page 3). Since there is no issue pending requiring a resolution of priority, Applicants deem this allegation as being moot and/or premature. Applicants reserve the right to defend and assert the benefit of an earlier filing date for this Application at a later time when an issue regarding priority becomes ripe.

Rejections under 35 U.S.C. § 103

Claims 1, 2, 4, 6, 7, 9-11, 12, 16, 17, 19, 21, 22, 24-26, 27

The Examiner has rejected claims 1, 2, 4, 6, 7, 9-11, 16, 17, 19, 21, 22, 24-26 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 6,516,341 to Shaw *et al.* ("Shaw") in view of U.S. Patent 5,848,396 to Gerace ("Gerace"). (See Office Action, page 3). Furthermore, the Examiner has rejected claims 12 and 27 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 6,516,341 to Shaw *et al.* ("Shaw") in view of U.S. Patent 5,848,396 to Gerace ("Gerace") in view of U.S. Patent 5,933,811 to Angles *et al.* ("Angles"). (See Office Action, page 3). Applicants respectfully traverse these rejections.

Applicants have amended independent claim 1 to include the features of claim 12, and thus traverse the rejection of claim 1 as if the rejection to claim 12 was applied thereto. For the Examiner's convenience, independent claim 1 as amended is recited below.

1. A computer implemented method for placing advertisements with interactive content on mobile, hand-held devices, comprising the steps of:

- (1) displaying an advertisement with interactive content on a hand-held device, wherein the advertisement is at least a portion of a web page adapted for the hand-held device based on display characteristics of the hand-held device, the web page including a response form having one or more fields;
- (2) pre-populating at least one field of the advertisement with address location information relating to the user of the hand-held device;
- (3) conditionally forwarding the at least one pre-populated field to an entity associated with the advertisement to provide information regarding the user to the entity;
- (4) **enabling a user of the hand-held device to conduct business with a provider related to a web site associated with the advertisement; and wherein revenue from said business is shared between the provider related to the web site and a provider related to a server that enables access to the web site.**

Even assuming, *arguendo*, that the combination of Shaw, Gerace, and Angles is proper, Shaw, Gerace, and Angles, alone or in combination do not teach or suggest each and every element, limitation, and/or feature of amended independent claim 1. Neither Shaw, Gerace, nor Angles teach or suggest, for example, revenue from the business shared between the provider related to the web site and a provider related to a server that enables access to the web site."

As admitted by the Examiner, "Shaw does not explicitly disclose enabling a user of the device to conduct business with a provider, wherein revenue from said business is shared between the provider and a server that enables access to the provider."

Gerace is directed toward a system for displaying, for example, a homepage that includes advertisements based on a user profile formed by monitoring a user's viewing of agate information. (See Gerace, abstract, column 4, lines 1-6). Gerace does not teach or suggest any revenue sharing.

Angles fails to overcome this deficiency. Angles is directed toward, for example, "content providers . . . receiv[ing] *advertising revenues* based on the number of consumers who access their websites" and "pay[ing] an Internet provider based on the number of advertisements viewed by its consumers. The Internet providers can use this *advertising revenue* to reduce consumer access fees." (See Angles, column 4, lines 20-23 and 44-47). Thus Angles suggests sharing of *advertising* revenues, not sharing of revenue from *business between the user and the provider* related to the website associated with the advertisement.

Moreover, Angles describes the sharing of revenue paid by the advertiser to the Internet provider with the consumer to reduce consumer access fees. Angles does not

teach or suggest the sharing of revenue from *business between the user and the provider* related to a web site associated with the advertisement with the provider related to a server that enables access to the web site.

Thus Shaw, Gerace, and Angles do not teach or suggest each and every feature of claim 1. Therefore, for at least the reasons above, Applicants respectfully request reconsideration and withdrawal of the rejection of claim 1, and allowance thereof. Furthermore, independent claim 16, as amended, is also patentable over Shaw, Gerace, and Angles for the reasons provided for claim 1, and further in view of its own features. Claims 2, 4, 6, 7, 9-11, which depend from claim 1, and claims 17, 19, 21, 22, 24-26, which depend from claim 16, are also patentable over Shaw, Gerace, and Angles for the reasons regarding their respective independent claims, and further in view of their own features. Accordingly, Applicants respectfully request that the rejection of claims 1, 2, 4, 6, 7, 9-11, 16, 17, 19, 21, 22, 24-26 be reconsidered and withdrawn. Furthermore, claims 12 and 27 have been canceled, so the rejection of these claims has been rendered moot.

Claims 3, 5, 18, and 20

The Examiner has rejected claims 3, 5, 18, and 20 under 35 U.S.C. § 103(a) as being unpatentable over Shaw in view of Gerace in view of U.S. Patent No. 5,794,210 to Goldhaber. ("Goldhaber"). (See Office Action, page 10). As described above, independent claims 1 and 16 are patentable over Shaw, Gerace, and Angles. Furthermore, Applicants assert that Goldhaber does not overcome the deficiencies of Shaw, Gerace, and Angles with respect to claims 1 and 16. Claims 3 and 5, which depend from claim 1, and claims 18 and 20, which depend from claim 16, are patentable

over Shaw, Gerace, Angles, and Goldhaber for at least the reasons provided herein with respect to their independent claims, and further in view of their own features. Thus, Applicants respectfully request that the rejection of claims 3, 5, 18, and 20 be reconsidered and withdrawn.

Claims 8, 23, 46 - 56

The Examiner has rejected claims 8 and 23 under 35 U.S.C. § 103(a) as being unpatentable over Shaw in view of Gerace in view of U.S. Patent 6,332,127 to Bandera et al. ("Bandera"). (See Office Action, page 11). As described above, independent claims 1 and 16 are patentable over Shaw, Gerace, and Angles. Furthermore, Applicants assert that Bandera does not overcome the deficiencies of Shaw, Gerace, and Angles with respect to claims 1 and 16. Claim 8, which depends from claim 1, and claim 23, which depends from claim 16, are patentable over Shaw, Gerace, Angles, and Bandera for at least the reasons provided herein with respect to their independent claims, and further in view of their own features. Thus, Applicants respectfully request that the rejection of claims 8 and 23 be reconsidered and withdrawn.

Furthermore, new independent claim 46 has been added, and incorporates features of claim 8, and new independent claim 53 has been added, and incorporates features of claim 23. As follows, Applicants traverse the Examiner's rejection of claims 8 and 23 as if the rejection was applied to claims 46 and 53.

For the Examiner's convenience, independent claim 46 is recited below.

46. A computer implemented method for displaying advertisements with interactive content on mobile, hand-held devices, comprising the steps of:

(1) synchronizing a hand-held device, wherein said synchronizing the hand-held device comprises downloading at least one advertisement with interactive content,

wherein the at least one advertisement is at least a portion of a web page adapted for the hand-held device based on display characteristics of the hand-held device;

- (2) operating the hand-held device in an **off-line mode**, comprising;
 - (a) **identifying** a **time** of day and a **location** of the device;
 - (b) **selecting** at least one downloaded **advertisement based on the identified time** of day and **location** of the device; and
 - (c) displaying the at least one selected advertisement;
 - (d) responding to a user interaction with the advertisement, including the step of pre-populating at least one field of the response to the advertisement with address location information relating to the user of the hand-held device;
 - (e) caching the pre-populated response form in the hand-held device;
- and
- (3) synchronizing the hand-held device subsequently to the synchronization of step (1) including the step of conditionally forwarding the at least one pre-populated field to an entity associated with the advertisement to provide information regarding the user to the entity.

Even assuming, *arguendo*, that the combination Shaw, Gerace, and Bandera is proper, Shaw, Gerace, and Bandera, alone or in combination, do not teach or suggest each and every element, limitation, and/or feature of claim 46. Neither Shaw, Gerace, nor Bandera teach or suggest, for example, in an off-line mode, "identifying a time of day and a location of the device" and "selecting at least one downloaded advertisement based on the identified time of day and location of the device."

Gerace is directed toward a system for displaying, for example, a homepage that includes advertisements based on a user profile formed by monitoring a user's viewing of aggregate information. (See Gerace, abstract, column 4, lines 1-6). Gerace does not teach or suggest any identifying or choosing advertisements based on device location and time of day.

The Examiner asserts that "Shaw discloses tracking at what time the user is presented certain content." Upon close review, Applicants have determined that Shaw at most suggests tracking the times the user is presented with certain advertisements and later reporting that information to the advertiser for purposes of determining advertising

payments: "[A]dvertisers prefer to pay for advertising based upon . . . whether its advertisements were actually viewed and for how long. . . ." (See Shaw, column 2, lines 47-54). The client program records what times advertisements were viewed, and stores them in an "advertisements statistics file" that is used to "create billing information." (See Shaw, column 6, lines 26-39). Thus, Shaw at most suggests tracking time to bill advertisers based on time of day, and does not address tracking location for any purpose. Nor does Shaw teach or suggest the targeting of advertising based on either location or time of day.

Bandera fails to overcome this deficiency. The Examiner asserts that "Bandera discloses targeting . . . a user for advertising based on location and time." Upon close review, Applicants have determined that Bandera at most states that "[i]n response to a user's request for a Web page via a mobile Web client *in communication with a Web server*, the mobile Web client retrieves information about the user's current location." (Bandera column 6, lines 46-49). Thus Bandera limits "Location-Based Advertising Generation" to relaying the user's request to the Web server. Thus Bandera does not teach or suggest "operating the hand-held device in an *off-line* mode" . . . "selecting at least one downloaded advertisement based on the identified time of day and location of the device." Therefore, each and every feature of claim 46 is not taught or suggested by Shaw, Gerace, and Bandera.

Therefore, for at least the reasons provided above, Applicants assert that independent claim 46 is patentable over Shaw, Gerace, and Bandera. Furthermore, independent claim 53 is also patentable over Shaw, Gerace, and Bandera for the reasons provided for claim 46, and further in view of its own features. Claims 47-52 and 54-56

depend from independent claims 46 and 53 respectively and are patentable for at least the reasons stated above, in addition to the elements, limitations, and/or features recited therein. Therefore, Applicants respectfully request the allowance of claims 46-56.

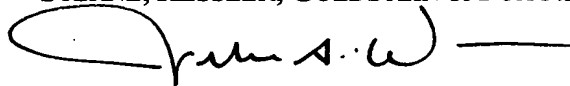
Conclusion

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding objections and rejections and that they be withdrawn. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment and Reply is respectfully requested.

Respectfully submitted,

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